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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,792	10/05/2005	Kilian Bott		2041

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03/13/2008

EXAMINER	
CRANE, DANIEL C	

ART UNIT	PAPER NUMBER
3725	

MAIL DATE	DELIVERY MODE
03/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,792

Applicant(s)

BOTT ET AL.

Examiner

Daniel C. Crane

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

REQUEST FOR CONTINUED EXAMINATION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2008 has been entered.

REJECTION OF CLAIMS ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contain new matter because the original disclosure fails to explicitly show or disclose that the inner right cylindrical surface and the outer right cylindrical surface have "identical" diameters along the "entire" axial length of the tubular shell body between the axially opposite terminal facing surfaces. In this regard, the press shell 18 and the sleeve (20?) are shown to have depressions that constitute differing diameters in the inner right cylindrical surface and the outer right cylindrical surface. Furthermore, the disclosure does not provide details of these claimed dimensional features. Applicants are incorporating these

limitations into the claims as essential features of the invention while the disclosure provides no discussion of the importance of these provisions.

SPECIFICATION OBJECTION

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claims refer to “inner right cylindrical surface”, “outer right cylindrical surface” and “opposite terminal annular axially oppositely facing surfaces”, however the specification does not illustrate or refer to these features.

The specification is further objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claims refer to a “tubular shell body (18)”, however, this label appears to be referring to the right cylinders 20(?) and 22. Reference numeral (18) is the “press shell”, by disclosure. Thus, there appears to be a disconnect between the claims and the disclosure because of the confused description between the claims and the specification. The claims have been examined as best understood per the lack of correspondence between the claims and the specification.

DRAWING OBJECTION

The drawings are objected to because the drawings fail to show numerals for an “inner right cylindrical surface”, an “outer right cylindrical surface” and “opposite terminal annular

axially oppositely facing surfaces”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are further objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters “20” and “22” have both been used to designate the same wax/lubricant layer or the same outer surface. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masters (3,777,354). Applicants' attention is directed to Figures 5-7 and column 4, lines 52-56, where

“(a)t any point during the swaging process, and most often at the beginning, it may be desirable to lubricate *the points of contact between the dies and the coupler* to ease the swaging process” (emphasis added).

Thus, substantially the entire length of the outer surface of the coupler C, which constitutes a press shell H that includes an inner substantially right cylindrical surface 56 having axially facing ends, is provided with a lubricant coating on an outer substantially right cylindrical surface of the shell body 51. The inner and outer substantially right cylindrical surfaces are shown to have identical diameters, particularly in the final shaping shown in Figure 6. Since the points of contact between the dies 27 and the coupler C are lubricated, it is maintained that an equivalent layer of lubricant is provided on the outer substantially right cylindrical surface of shell body 51 to that lubricant claimed. This oil would function identically to the claimed “one of a wax layer and a solid lubricant layer”. (Note that applicants' own specification specifies that “oils” may be used (see paragraph [0011]). As long as the outer surface is a coating and functions to lubricate the outer substantially right cylindrical surface during the shaping operation, the lubricating coating on the outer right cylindrical surface does not affect the overall product. As to Masters' non-metallic press shell H, this material is also considered equivalent to the claimed non-iron metal or non-iron metal alloy press shell since applicant's own disclosure

indicates that plastic can be an alternative shell material (see paragraphs [0005] and [0006]). Accordingly the shell material is preferential as long as the outer right cylindrical surface can be shaped against the inner right cylindrical surface of the press shell to result in a secure deformation joint.

INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(571) 272-4516**. The examiner's office hours are 7:00AM-3:30PM, Monday through Friday.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number **(571) 273-8300**. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's Fax number is **(571) 273-4516**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCCrane
March 4, 2008

/Daniel C Crane/
Daniel C. Crane
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